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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/914,033

08/22/2001

Ieyasu Kobayashi

8235

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Rader Fishman & Grauer
1233 20th Street N W Suite 501
Washington, DC 20036

EXAMINER

RIVERA, WILLIAM ARAUZ

ART UNIT

PAPER NUMBER

3654

MAIL DATE

DELIVERY MODE

09/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/914,033

Applicant(s)

KOBAYASHI ET AL.

Examiner

William A. Rivera

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,9,13-15 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6,9,13-15 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is vague and indefinite. On line 7, the term "Rc" is unclear. What does "Rc" stand for?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al (U.S. Patent No. 4,576,344).

With respect to Claim 6, Sasaki et al teach a polyester film roll 4 free from wrinkles and rolled on a core 2; the film roll having a maximum diameter and a minimum diameter when all diameters are measured along the width direction of the roll; and the difference R between the minimum diameter value is not more than $2W \times 10^{-3}$ because the width of the roll is uniform throughout the roll and such is the case for the condition $L \times 10^{-7}$.

Sasaki et al do not mention the specific dimensions in terms of the difference "Rc" between the maximum value and the minimum value. However, it would have been an obvious matter of design choice, as determined through routine experimentation and optimization, to dimension the polyester film roll of Sasaki et al as specified in Claim 6, line 8 because one of

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ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use. Moreover, the same person of ordinary skill in the art would have appreciated the desirability of limiting the difference between the maximum diameter and the minimum diameter of the cylindrical object in order to provide uniformity to the cylindrical object. Therefore, because the polyester film roll of Sasaki has the same film length, width, thickness, and rolling hardness as the applicants' polyester film roll, and achieves the same result of a wrinkle free film, therefore it would have been obvious that Sasaki's working examples necessarily have maximum and minimum diameters sufficiently close to meet the relationship set forth in the claim and also be able to meet the difference R_c between that maximum value and the minimum value.

With respect to Claim 9, Sasaki et al teach a polyester film roll 4 free from wrinkles and rolled on a core 2; the film roll having a maximum diameter and a minimum diameter when all diameters are measured along the width direction of the roll; and the difference R between the minimum diameter value is not more than $2W \times 10^{-3}$ because the width of the roll is uniform throughout the roll and such is the case for the condition $L \times 10^{-7}$.

Sasaki et al do not mention the specific dimensions in terms of the flexural modulus of the core in the circumferential direction. However, it would have been an obvious matter of design choice, as determined through routine experimentation and optimization, to dimension the core of the polyester film roll of Sasaki et al as specified in Claim 9, lines 7-8 because one of ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use.

Claims 13-15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al (U.S. Patent No. 4,576,344) in view of Ogawa et al (U.S. Patent No. 4,911,951).

With respect to Claims 13-15, Sasaki et al teach a polyester film roll 4 free from wrinkles and rolled on a core 2; the film roll having a maximum diameter and a minimum diameter when all diameters are measured along the width direction of the roll; and the difference R between the minimum diameter value is not more than $2W \times 10^{-3}$ because the width of the roll is uniform throughout the roll and such is the case for the condition $L \times 10^{-7}$; wherein the polyester film is a film used for the support of a magnetic recording medium (see column 8, lines 55-57).

Sasaki et al teach all the elements of the roll except for the roll having a ferromagnetic layer and the coating layer being rolled in the inner side. However, Ogawa et al, Figures 1 and 2, and Column 1, lines 50-62, teach the use of a ferromagnetic layer and the magnetic layer being disposed on the inside. It would have been obvious to one of ordinary skill in the art to provide a ferromagnetic layer to the roll, as taught by Ogawa et al, for the purpose of utilizing the roll with magnetic recording media. It would have further been obvious to one of ordinary skill in the art to wind the roll with the coating layer on the inside, as taught by Ogawa et al, for the purpose of protecting the layer from foreign substances. Also, the use of magnetic recording medium for digital recording is notoriously old and well known. As such, it would have been obvious to one of ordinary skill in the art that the magnetic recording medium could be used for a digital recording.

With respect to Claim 23, Sasaki et al, teach a polyester film roll in which a polyester film is rolled on a core, said polyester film roll having a plurality of diameters obtained from measurements along the width direction of the roll, said plurality of diameters being represented

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by a curved line having two ends, said plurality of diameters comprising a maximum diameter and a minimum diameter, said maximum diameter being represented by a first maximum perpendicular line length which is determined by a straight line drawn connecting both ends of the curved line, and a first perpendicular line with respect to said straight line drawn from the maximum convex area of said curved line to said straight line, said minimum diameter being represented by a second maximum perpendicular line length which is determined by a second perpendicular line with respect to said straight line drawn from the maximum concave area of said curved line to said straight line. Sasaki et al teach all the elements of the roll except for the length of the lines and the magnetic layer being a magnetic type. However, Ogawa et al, Figures 1 and 2, and Column 1, lines 50-62, teach the use of a magnetic layer being the coating type. It would have been obvious to one of ordinary skill in the art to provide a coating type to the roll, as taught by Ogawa et al, for the purpose of utilizing the roll with magnetic recording media.

Sasaki et al do not mention the specific dimensions of the length of the lines. However, it would have been an obvious matter of design choice, as determined through routine experimentation and optimization, to dimension the length of the lines of Sasaki et al as specified in Claim 23, lines 12-13 because one of ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use.

Response to Arguments

Applicant's arguments with respect to claims 6, 9, 13-15 and 23 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William A. Rivera whose telephone number is 571-272-6953. The examiner can normally be reached on Monday to Friday - 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Q. Nguyen can be reached on 571-272-6952. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

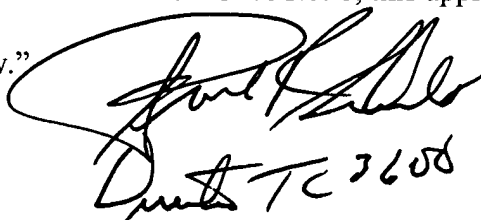
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William A Rivera/
Primary Examiner, Art Unit 3654

August 28, 2009

Approval for Reopening of Prosecution

"In accordance with 37 CFR 1.198, this application is being reopened with Director approval below."



Director TC 3608